

REMARKS

As a result of the amendments made herein, Claims 42-83 remain pending. Claims 48, 54, 60, 70 and 77 have been amended. No new matter has been added. Accordingly, Claims 42-83 are at issue.

Remarks Concerning Rejections Under 35 U.S.C. § 112

On page 3 of the March 30, 2005 Office Action, the Examiner rejected Claims 77-83 under 35 U.S.C. § 112, ¶ 1, as failing to comply with the written description requirement. In particular, the Examiner found that "randomly selecting one of the time positions", which is a limitation in Claim 77, is not described in the specification. In light of the amendment made herein to Claim 77, Applicants respectfully traverse that rejection.

Claim 77 has been amended to clarify that each advertisement is associated with a value indicating a percentage of the time slots. Claim 77 has also been amended to clarify that a time slot is then selected in accordance with that value. Those steps are amply disclosed and described on page 10 of the specification as originally filed. The word "randomly" has been deleted from Claim 77. Applicants therefore submit that Claim 77, as amended, complies with the written description requirement of § 112. Claims 78-83 are dependent on Claim 77, and therefore do not pose any § 112 issues based on Claim 77 in view of the amendments made to Claim 77. Applicants therefore respectfully request that the § 112 rejection of Claims 77-83 be withdrawn.

Remarks Concerning Rejections Under 35 U.S.C. § 102

U.S. Patent No. 6,674,357 to Bermel ("Bermel")

On page 4 of the March 30, 2005 Office Action, the Examiner rejected Claims 48 and 70 as being anticipated by Bermel. In light of the amendments made herein, Applicants respectfully traverse that rejection.

Bermel is directed to an apparatus for displaying informational messages communicated wirelessly to a plurality of display devices. The messages are each placed in a "slot" in the memory of the display device (col. 5, ll. 3-7). The messages are then displayed in sequence, with the duration of the display depending on the type of the message (col. 5, ll. 48-55). Bermel does not assign a unique duration to each message. Rather, each *type* of message is assigned a duration, and the messages are displayed according to their *type*. For example, news messages are displayed for thirty seconds, and advertisements are displayed for fifteen seconds (*Id.*). Nowhere in Bermel is it disclosed that each message has a unique or particular duration; Bermel discloses only that the duration of the message is determined by the *type* of the message that is being displayed.

In the present invention, each advertisement *has its own* duration for display. Instead of basing the duration on the *type* of the advertisement, as in Bermel, the present invention assigns each advertisement its own duration. That element is not disclosed in Bermel. Moreover, Claim 70 provides that each of the set of advertisements is *uniquely* associated with each of the set of periods of time. In other words, each advertisement has *its own* duration, which is not based on the type or content of the advertisement.

Claims 48 and 70 have both been herein amended to clarify that the duration of the advertisement is not based on the content of the advertisement, as disclosed in Bermel. Instead, the present invention provides that each advertisement has its own unique display duration. Bermel does not disclose or suggest that limitation, and therefore Applicants respectfully request that the § 102 rejection based on Bermel be withdrawn.

U.S. Patent No. 6,031,467 to Hymel et al. ("Hymel")

On page 5 of the March 30, 2005 Office Action, the Examiner rejected Claims 54-55 and 60 as being anticipated by Hymel. In light of the amendments made herein, Applicants respectfully traverse that rejection.

Hymel is directed to a selective call radio (SCR) that receives personal messages and corresponding advertisement messages. To view personal messages on the SCR, the user is required to first view an advertisement. If the user views the personal message *without* viewing

the advertisement, the user is penalized by having the SCR's message-receiving capability disabled (col. 4, ll. 41-54).

In the present invention, users receive paging information. Upon receipt of the paging information, the user first views an advertisement, and then views the paging information. The user may then store the paging information for later viewing. Upon the *second* viewing of the paging information, the user does not have to view the advertisement; the user can select to view the paging information a second time without viewing the advertisement. There is a user preference which allows the user to determine whether she wants to view the advertisement upon a *second* viewing of the paging information. Hymel does not disclose that feature.

Hymel states only that the user "inadvertently places the SCR 122 in a condition where advertisement messages cannot be received" (col. 4, ll. 63-65). That is not the same thing as a user preference, because (a) it is by definition inadvertent, whereas a user preference is an intentional user choice, and (b) the SCR as described by Hymel does not provide the user with an opportunity to establish that preference, whereas the display device described in the present invention *does* provide the user with the opportunity to establish that preference. Moreover, while Hymel indicates that it is somehow possible to receive messaging information without receiving advertisement information, Hymel makes no disclosure whatsoever as to how that step is actually accomplished. A non-enabling disclosure in a prior art reference cannot be used as the basis of a § 102 rejection (Chester v. Miller (Fed. Cir. 1990), 906 F.2d 1574; Scripps Clinic & Research Found. v. Genentech, Inc. (Fed. Cir. 1991), 927 F.2d 1565).

Moreover, Claims 54 and 60 have been herein amended to clarify that subsequent to the first viewing of the paging information, a user preference is detected to determine whether the user prefers to view the paging information without viewing the advertising information. If the user preference is detected, the user can view the paging information without viewing the advertising information. Hymel does not disclose that limitation, and therefore Applicants respectfully request that the § 102 rejection based on Hymel be withdrawn. Claim 55 is dependent on Claim 54, and is therefore patentable over Hymel for the same reasons.

Remarks Concerning Rejections Under 35 U.S.C. § 103

Hymel in view of U.S. Patent No. 6,429,812 to Hoffberg ("Hoffberg")

On page 6 of the March 30, 2005 Office Action, the Examiner rejected Claims 42 and 64 as being unpatentable over Hymel in view of Hoffberg. In light of the amendments made herein, Applicants respectfully traverse that rejection.

Hoffberg is directed to a mobile communications device comprising a location sensing system producing a location output. The Hoffberg device combines "event information" with "itinerary information" (col. 24, ll. 40-49). The Examiner has equated the "itinerary information" of Hoffberg with the "user preference" of the present application, and has based the § 103 rejection on that equivalence. That equivalence, however, is improper for at least two reasons.

First, the "itinerary information" described in Hoffberg is not generated by a user, and in fact does not represent a user preference in any way. In fact, the "itinerary information" in Hoffberg is generated by the device, not by the user. The Hoffberg device is in essence a GPS navigational system such as those used in automobiles; the "itinerary information" is simply a set of steps, i.e. directions, that the user is to follow to achieve a desired location. In fact, the Hoffberg patent uses the term "route" interchangeably with the word "itinerary" (col. 24, ll. 40-49).

In the present invention, a "user preference" determines whether a user desires to view advertisements upon subsequent viewing of paging information. The user preference of the present invention is therefore nothing at all like a route for driving directions. The "itinerary" of Hoffberg (even if it is user-provided, which Hoffberg does not disclose) does not determine whether advertising information is displayed upon subsequent viewing of paging information, and therefore does not render obvious the user preference of the present invention.

Neither Hymel nor Hoffberg, alone or in combination, disclose a user preference which is used to determine whether advertising information is displayed upon subsequent viewing of paging information, and therefore Applicants respectfully request that the § 103 rejection based on those references be withdrawn.

In addition to failing to disclose each of the limitations of the independent claims of the present invention, the combination of Hymel and Hoffberg is improper because there is no motivation or incentive in the prior art to combine those references in the manner suggested by the Examiner (In re Napier (Fed. Cir. 1995), 55 F.3d 610, 613). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art (In re Fine (Fed. Cir. 1988), 837 F.2d 1071, 5 USPQ2d 1596; In re Jones (Fed. Cir. 1992), 958 F.2d 347, 21 USPQ2d 1941).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure (In re Vaeck (Fed. Cir. 1991), 947 F.2d 488, 20 USPQ2d 1438). The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness (MPEP § 2142). In the present case, the Examiner has failed to meet that burden. Instead, the Examiner has simply concluded one skill in the art would make the suggested modification. That is insufficient.

Hymel is from the field of selective call radios receiving personal messages, and Hoffberg is from the field of satellite-controlled navigation systems. It would not have been obvious to one of ordinary skill in either field to combine the references in the manner suggested by the Examiner, nor is there any incentive or suggestion in either of the references to do so. Applicants therefore respectfully submit that the combination of Hymel and Hoffberg is an improper § 103 combination, and request that the rejection based on those references be withdrawn.

Bermel in view of Hymel

On page 11 of the March 30, 2005 Office Action, the Examiner rejected Claim 77 as being unpatentable over Bermel in view of Hymel. In light of the amendments made herein, Applicants respectfully traverse that rejection.

Bermel teaches that a plurality of advertisements are each assigned to a "slot", and that the "slots" are displayed in order; i.e., the advertisements are displayed according to a predetermined schedule (col. 5, ll. 37 et seq.). In Hymel, it is stated simply that "the message is recovered" from the memory of the device, although Hymel does not specify exactly *how* the message is recovered from memory (col. 3, ll. 6-12). Neither of those references, either alone or in combination, disclose that the advertisement is selected *randomly*.

Nonetheless, Claim 77 has been herein amended to clarify that each advertisement is associated with a value, which indicates the percentage of time slots that will be associated with that advertisement. A time slot is chosen in accordance with that value, which results in the advertisement being displayed the desired percentage of times.

The combination of Bermel and Hymel discloses, at best, that advertisements are displayed in a predetermined sequence and are retrieved from memory. The present invention, however, selects advertisements based on a value indicating a percentage of time slots associated with each advertisement. Neither Bermel nor Hymel disclose or suggest that feature, and therefore Applicants respectfully request that the § 103 rejection based on those references be withdrawn.

The Examiner has also rejected all of the dependent claims of the present application under § 103, namely Claims 43-47, 49-53, 55-59, 61-63, 65-69, 71-76 and 78-83. The independent claims on which they depend (Claims 42, 48, 54, 60, 64, 70, and 77) have all been amended by this Reply. In light of those amendments, Applicants submit that all of the independent claims of the present invention are patentable over all of the cited references. For the same reasons as provided herein with respect to the independent claims, the dependent claims are patentable as well.

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CONCLUSION

In light of the amendments and remarks made herein, Applicants respectfully submit that Claims 42-83 are in condition for allowance. Applicants respectfully request that the Examiner withdraw the rejections and allow the claims to issue. If it may be of assistance to contact the Applicants regarding the present invention, the Examiner is invited to do so. The Commissioner is hereby authorized to charge Deposit Account No. 23-0280 in connection with any fees associated herewith.

Respectfully submitted,

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CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)

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